

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks and accompanying information, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-5, 7, and 10-14 are currently under consideration. Claims 1 and 3-5 are amended, claims 6, 8, and 9 are canceled, and claims 10-14 are newly added without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

No new matter is added.

It is submitted that the claims herewith are patentably distinct over the prior art, and these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claims presented herein are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply to clarify the scope of protection to which Applicants are entitled.

Support can be found throughout the specification and from the claims as filed. The amendment to claims 1 and 3-5 clarify the claimed subject matter. Support for newly added claims 10-12 can be found, for example, on page 7, lines 9-12 of the specification. Support for newly added claims 13 and 14 can be found, for instance, on page 6, lines 5-11, and in Example 1 of the specification.

II. RESTRICTION REQUIREMENTS

The Office Action of April 10, 2007 requires an election under 35 U.S.C. § 121 from among the following:

- I. Claims 1-4 and 7, drawn to a composition.
- II. Claims 5 and 6, drawn to a method of preparation.

Applicants hereby elect, with traverse, the claims of Group I, namely claims 1-4 and 7, for further prosecution in this application. Applicants reserve the right to file divisional applications to non-elected subject matter.

Applicants have amended the claims of Group I such that claim 1 recites *Cavalia gladiata* and *Biota orientalis*, and claims 3 and 4 are herein independent of claim 1. Applicants respectfully submit that the amendment herein does not alter the claims in such a manner that a further Restriction Requirement is necessary. Furthermore, Applicants respectfully submit that newly added claims 10-12 should be examined as part of elected Group I. These added claims are dependent on the claims of Group I and present embodiments of the formulations of claims 2-4.

In addition, the Office Action required election of a species. In response, Applicants hereby elect, with traverse, *Cavalia gladiata*.

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. (MPEP § 803) Second, searching the additional inventions must constitute an undue burden on the Examiner if restriction is not required. *Id.* The MPEP directs the Examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions.” *Id.*

It is respectfully submitted that the criteria listed in MPEP § 803 have not been met in this case, as no showing has been made that an undue burden would be placed on the Examiner. The present application relates to topical formulations for preventing acne comprising plant extracts, and methods of preparing these formulations. Accordingly, there is a relationship among the polypeptides and methods disclosed in the present invention.

Indeed, any search for the formulations of the claims in Group I would certainly be co-extensive with the claims of Group II. Specifically, as the present claims of Group I are directed to topical formulations comprising plant extracts, such claims are interrelated with the claims of Group II which are drawn to a method of preparing these formulations. As such, the search for the claims of Groups I and II would certainly be co-extensive.

The Office Action contends that the claims lack unity of invention, because there is no definable special technical feature. According to the Office Action, the technical feature of a topical formulation comprising an extract from *Coptis chinensis* is allegedly taught by Niazi

(U.S. Patent No. 6,419,963). In response, Applicants draw attention to amended claim 1, which clarifies the subject matter as a topic formulation comprising extract “obtained from one oriental medicine selected from the group consisting of *Cavalia gladiata* and *Biota orientalis*.” The claimed invention is not anticipated by Niazi, which is related to a composition containing *Coptis chinensis* as the only extract. Therefore, the present claims indeed disclose a formulation that is not anticipated by the prior art, and thereby constitutes a special technical feature.

In addition, this special technical feature is shared among all of the claims and indicates that there is a special technical relationship among the claims of Groups I and II. Referring to the Office Action, the present invention qualifies as having unity of invention under category 1: “a product and a process specially adapted for the manufacture of said product.” Clearly, the methods of claim 5 and newly added claims 13 and 14 are specially adapted to preparing a topical formulation from *Cavalia gladiata*, *Biota orientalis*, and/or *Coptis chinensis*. Therefore, the claims of Group I and Group II fulfill the unity of invention requirement.

Furthermore, the Applicants respectfully traverse the election of species. In view of M.P.E.P. §803, a requirement for election is inappropriate when the generic claim includes sufficiently few species that a search and examination of all the species at one time would not impose a serious burden on the examiner. For the present application, only three types of plant extracts are presented.

Indeed, the Examiner's attention is directed to MPEP § 803.02, which states:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. (Emphasis added.)

In accordance with the above, Applicants respectfully submit that the Species Election should be withdrawn, as the MPEP itself indicates that search and examination of plants that are few in number do not constitute a serious burden.

Thus, Applicants respectfully request the Examiner withdraw the election of species.

Enforcing the present restriction requirement and election of species would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper,

especially since the requisite showing of serious burden has not been made in the Office Action and there are relationships between the claimed combinations. Indeed, the search and examination of Groups I and II would involve such interrelated art that the search and examination of Groups I and II can be made without undue burden on the Examiner. All of the preceding, therefore, mitigate against restriction.

In view of the above, reconsideration and withdrawal of the Requirement for Restriction and election of species are requested, and an early action on the merits earnestly solicited.

Respectfully submitted,

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